

### **REMARKS**

In the Official Action dated May 5, 2004, Claims 1-27, 30 and 31 have been rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,696,464. Claim 31 has been rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 31 is rejected under 35 U.S.C. §101 as allegedly claiming the recitation of a use without setting forth any steps involved in the process. Claims 1-27, 30 and 31 have been rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1-5, 15 and 51-53 of U.S. Patent No. 6,696,464.

This response addresses each of the Examiner's objections and rejections. Accordingly, the present application is in condition for allowance. Favorable consideration of all pending claims is therefore respectfully requested.

Claims 28, 29, 32 and 33 have been cancelled for being drawn to a non-elected subject matter. Applicants reserve the right to file continuing applications drawn to the deleted subject matter. No new matter has been added and no narrowing amendments have been made. Applicants respectfully request entry of this amendment.

Claims 1-27, 30 and 31 have been rejected under 35 U.S.C. §103(a) as allegedly unpatentable over U.S. Patent No. 6,696,464. Applicants respectfully traverse.

The '464 patent cannot preclude patentability of the claimed invention under 35 U.S.C. § 103(c). 35 U.S.C. § 103(c) states that

“Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude

patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person”.

In the instant case, the ‘464 patent and the present application are both assigned to Pfizer Inc. Because the ‘464 patent can only qualify as prior art under subsection (e) of 35 U.S.C. §102, 35 U.S.C. §103(c) dictates that the ‘464 patent does not preclude patentability of the claimed invention.

Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection under 35 U.S.C. §103(a).

Claim 31 has been rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner alleges that Claim 31 provides for the use of the treatment of arthritis, but does not set forth any steps involved in this process. Applicants respectfully submit that Claim 31 is a pharmaceutical composition claim. There is no method or use language in Claim 31. Claim 31 merely describes a pharmaceutical composition containing a compound according to claim 1 in an amount effective in treating a condition described in claim 31, and a pharmaceutically acceptable carrier. Since Claim 31 is a proper pharmaceutical composition claim, Applicants respectfully request reconsideration and withdrawal of this rejection.

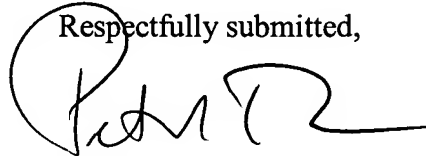
Claim 31 was also rejected under 35 U.S.C. §101 for allegedly claiming the recitation of a use without setting forth any steps involved in the process. For the same reasons stated above, Claim 31 merely describes a pharmaceutical composition containing a compound according to claim 1 in an amount effective in treating a condition described in claim 31, and a

pharmaceutically acceptable carrier. Since Claim 31 is a pharmaceutical composition claim and not a process claim, Applicants respectfully request reconsideration and withdrawal of this rejection.

Claims 1-27, 30 and 31 have been rejected under the judicially created doctrine of obviousness-type double patenting as allegedly unpatentable over claims 1-5, 15 and 51-53 of U.S. Patent No. 6,696,464. In response, Applicants will submit in due course a terminal disclaimer in compliance with 37 CFR §1.321(c) signed by a registered attorney of record. Accordingly, Applicants respectfully request reconsideration and withdrawal of this rejection.

Thus, in view of the foregoing amendments and remarks, the application is in condition for allowance, which action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Peter I. Bernstein", written over a circular stamp or seal.

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